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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,206	12/28/2001	Teruo Masaki	7217/66286	8257
530	7590	05/09/2006	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/033,206	Applicant(s) MASAKI ET AL.	
	Examiner James A. Reagan	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in response to the amendment filed on 21 February 2006.
2. Claims 1, 5, 6, 12, 13, and 17 have been amended.
3. Claims 1-17 have been examined.

## **RESPONSE TO ARGUMENTS**

4. Applicant's arguments received on 21 February 2006 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the amended limitation of "detecting copyrighted work data in communication data uploaded from a client on the open communication network for supply to a server", Applicant argues that Stefik et al. fails to teach or suggest sending copyrighted data from a client machine to a server. Stefik discloses sending copyrighted material from a server to a client. Applicant, in the background of the specification discloses uploading data from a client to a server. It would have been an obvious modification of Stefik to include transmitting protected data back to the server because, as disclosed by the Applicant on page 2 of the specification, "Using web pages, Internet addresses from...can be easily accessed." In Figure 1 of Stefik, a user is shown to create a digital work and upload it to a repository for controlled dissemination.

Clearly, before a protected work can be downloaded from a server for rendering, it must first be uploaded.

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US 5,629,980 A), in view of the Applicant's own admissions.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1-17:**

Stefik discloses the prevention of the unauthorized distribution of copyrighted digital works, thereby disclosing the limitations of claims 1-17. See at least the abstract; column 1, lines 10-13; column 1, lines 44-46; column 2, lines 1-22; Figure 1 and associated text, as well as other relevant text throughout the reference. Stefik also discloses a deletion function, but does not specifically disclose destroying communication data. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Stefik's deletion technique to include deleting any files and/or associated with an unauthorized transfer of digital material because this would likely inhibit or prevent a fraudulent digital file transaction from occurring.

In addition, although Stefik does disclose deletion of data, Stefik does not disclose *program data for prohibiting the copyrighted work data from being transmitted is transmitted to the client so as to prohibit the communication data from being transmitted*, Applicant, in the background of the specification does. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Stefik with Applicant's admissions because preventing fraudulent use of digital copyrighted data entails deletion of digital data, as disclosed by both Stefik and Applicant.

With regard to the amended limitation of "detecting copyrighted work data in communication data uploaded from a client on the open communication network for supply to a server", Applicant argues that Stefik et al. fails to teach or suggest sending copyrighted data from a client machine to a server. Stefik discloses sending copyrighted material from a server to a client. Applicant, in the background of the specification discloses uploading data from a client to a server. It would have been an obvious modification of Stefik to include transmitting protected data back to the server because, as disclosed by the Applicant on page 2 of the specification, "Using web pages, Internet addresses from...can be easily accessed." In Figure 1 of Stefik, a user is shown to create a digital work and upload it to a repository for controlled dissemination. Clearly, before a protected work can be downloaded from a server for rendering, it must first be uploaded.

**Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
8. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3621

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on 8:00a - 5:00p M-F. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**571-273-8300** [Official communications, After Final communications labeled "Box AF"]

**571-273-8300** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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401 Dulany Street

Alexandria, VA 22314.

JAMES A. REAGAN

Primary Examiner

Art Unit 3621

01 May 2006



**JAMES A. REAGAN  
PRIMARY EXAMINER**